

REMARKS

The present reply is in response to the Office action dated June 19, 2007, where the Examiner has maintained the rejection of claims 1 – 13 and 20 – 28. By this amendment, claims 1, 7, 23, and 24 have been amended and claim 20 has been cancelled. Claims 1 - 13 and 21 - 28 remain pending in the present application with claims 1, 7, 23, and 24 being the independent claims. Reconsideration and allowance of pending claims 1 – 13 and 21 – 28 in view of the present amendments and remarks are respectfully requested.

A. Rejection of Claims 1 – 6 and 21 Under 35 USC §103

In the Office Action, claims 1 – 6 and 21 have been rejected under 35 U.S.C. 103(a) as unpatentable over U.S. Publication No. 2004/0005889 ("Shanahan") in view of U.S. Publication No. 2002/1023336 ("Kamada") and further in view of U.S. Patent No. 6,678,361 ("Rooke"). The Office Action relies primarily on Shanahan as teaching the elements of the claims and states that the combination of Shanahan with Kamada and Rooke would have been obvious to a person of ordinary skill in the art. This rejection is traversed as follows.

A claim is unpatentable if the differences between it and the cited references would have been obvious at the time of the invention. As stated in MPEP § 2143, there are three requirements to establish a *prima facie* case of obviousness.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the cited reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion

to make the claimed combination and the reasonable expectation of success must both be found in the cited references, and not based on Applicant's disclosure.

1. Suggestion or Motivation to Combine

The Office Action cites Kamada and Shanahan as teaching all of the limitations of the cited claims, except "obtaining profile information from the wireless communication device, the profile information comprising a data storage capacity of the wireless communication device." The Examiner cites Rooke for the teaching of this element.

The present claims include an "account status" as a portion of the profile and the menu is provided only if the "account status is current." Neither Kamada nor Rooke teach an "account status" as a portion of the profile. Kamada is related to a "software sales method." (See, Kamada, Paragraph 0013). As such, Kamada is interested in selling its software to anyone who pays for it. As such, Kamada teaches away from the concept of invalidating a user's access if their account status is not current, since Kamada would direct a person having ordinary skill in the art to provide to tools or software as long as the credit card of the user is able to be charged.

Similarly, Rooke is concerned with delivering messages between devices. (See, Rooke, Column 2, Lines 16-29) In Rooke, the profile is concerned with the features of the devices in order to determine whether the messages can be delivered. (See, Rooke, Column 1, Lines 37-42, citing the fact that as messages are received the available memory is reduced.) In Rooke, there is no suggestion that the user profile could contain account status information, nor that the messages could be prevented from being sent should the user's account status not be current. In fact, Rooke teaches away from having account status as an element of the user profile because it is

assumed in Rooke that since a communicative coupling is established between the entities already in preparation for exchanging messages, the account status is already current or it is not relevant to have that information in the profile.

Because the Office Action has not cited any motivation taught by the references themselves to combine the diverse systems of Shanahan, Kamada, and Rooke, Applicant respectfully submits that the only logical connection between the references is the general concept of moving data over a wireless network, and that the cited reference is only modified in retrospect, in light of the present claim. That is, the obviousness rejection is based upon the Applicant's own characterization, not any modification actually suggested by the references themselves. As such, neither Rooke nor Kamada create a suggestion or motivation to combine to achieve the current claims.

2. Reasonable Expectation of Success

Further, the Examiner has not demonstrated that the modification of Shanahan with the contrasting teachings of Kamada and Rooke points to the reasonable expectation of success in the present claims, which is the second requirement of the obviousness analysis. As previously stated, the teachings of Shanahan oppose the teachings of Kamada and Rooke.

Shanahan teaches a system that stores information on the handset while Kamada and Rooke both teach obtaining a profile for the purposes of selling software or facilitating the exchange of messages. Checking for an account status in Kamada and Rooke would be a wasteful and unnecessary step. In Kamada, the goal is to sell software and parties that connect to the system that have a credit card. In theory, Kamada teaches selling the item to anyone that wants to purchase it, so invalidating a user on the basis of account status diminishes the goal of selling software.

Likewise in Rooke, since the parties are exchanging messages, it is generally the case that the users have a valid account status (since they are connected to the network). As such, including account status as a feature in the user profile serves no purpose and would waste the limited memory available in the devices that is available for other pertinent user profile information. In fact, Rooke keeps track of the amount of available memory for the very reason that each received message reduces the amount of available memory. Therefore, having account status as a user profile element in memory makes Rooke less functional as it would have less available memory for its intended purpose of exchanging messages. As such, neither Kamada nor Rooke, in combination with Shanahan could reasonably be expected to succeed in achieving the present claims.

3. Combined References Must Teach All Claim Limitations

With respect to the third prong of an obviousness analysis, the combination of the references does not yield all the limitations of the claims. Specifically, claim 1 requires that the connectivity toolkit server obtains profile information for a connecting wireless communication device and that the profile information includes "an account status." Moreover, the connectivity toolkit utilities are only provided if the account status is current. Support for these amendments can be found at least in paragraph 29.

The Office Action cites Kamada and Rooke as teaching profile information, but nowhere in Kamada or Rooke is a teaching or suggestion that an account status is part of the profile. Accordingly Kamada and Rooke in combination with Shanahan fail to teach this aspect of the claims.

4. Effect of KSR

After the recent Supreme Court decision in the KSR case, although it is clear that the above analysis using the Federal Circuit's teaching-suggestion-motivation test is not the only way to approach the obviousness inquiry, it remains a useful tool in the obviousness inquiry. However, even if an alternative tool is employed as part of the obviousness inquiry, it is clear from KSR that any combination of references in an obviousness rejection must provide reasonable inferences that are based on substantial evidence in the record. Here, no such substantial evidence has been identified and therefore even after KSR, Applicant asserts that the pending claims are not obvious in view of the cited references of record.

Summary

In summary, the Office Action cites no passages in the references themselves that suggest or provide any motivation to combine the teachings of Shanahan with Kamada and Rooke. Further, the Examiner has not demonstrated that the modification of the cited reference points to the reasonable expectation of success in the present claims, which is the second requirement of the obviousness analysis. Finally, the combination of Shanahan, Kamada, and Rooke fail to teach independent claim 1. Thus, the combination of Shanahan with Kamada and Rooke fails to make the claims obvious and Applicant respectfully requests that the rejection of independent claim 1 and its respective dependent claims be withdrawn.

B. Rejection of Claims 7 – 13 Under 35 USC §103

In the Office Action, claims 7-13 have been rejected under 35 U.S.C. 103(a) as unpatentable over Shanahan in view of Kamada. The Office Action relies primarily on Shanahan as teaching the elements of the claims and states that the combination of

Shanahan with Kamada would have been obvious to a person of ordinary skill in the art. This rejection is traversed as follows.

A claim is unpatentable if the differences between it and the cited references would have been obvious at the time of the invention. As stated in MPEP § 2143, there are three requirements to establish a *prima facie* case of obviousness.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the cited reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the cited references, and not based on Applicant's disclosure.

1. Suggestion or Motivation to Combine

The Office Action cites Shanahan as teaching all of the limitations of the cited claims, except "a reserved data storage area for the wireless communication device for uploading and downloading of files." Applicant has amended independent claim 7 to include the limitation of a utility program that comprises "a plurality of discrete computer programs managed by an administrative program that allows a single user interface to the plurality of discrete computer programs, the administrative computer program allowing operation of a first of the discrete computer programs which enables access to a portion of the data storage area reserved for the wireless communication device for uploading files and allowing operation of a second of the discrete computer programs which enables access to a portion of the data storage area reserved for the wireless communication device for downloading of files."

Neither Shanahan nor Kamada suggest this limitation. Kamada does not deal with a utility toolkit so it correspondingly does not separate the utility toolkit into discrete computer programs. Shanahan does not suggest this limitation either. Even if Shanahan can be described as a "utility toolkit" there is no teaching of a user interface. Instead, Shanahan gives a list of functions that can be performed by a computer. (See, for example, paragraph 0038 of Shanahan). However, Shanahan does not teach that these functions are part of a user interface or even displayed to the user. Furthermore, Shanahan does not suggest breaking up the uploading and downloading functions to discrete computer programs under the control of an administrative program.

As such, neither Shanahan nor Kamada create a suggestion or motivation to combine to achieve the current claims.

2. Reasonable Expectation of Success

Further, the Examiner has not demonstrated that the modification of Shanahan with the contrasting teachings of Kamada points to the reasonable expectation of success in the present claims, which is the second requirement of the obviousness analysis. As previously stated, the teachings of Shanahan oppose the teachings of Kamada.

Shanahan teaches a system that stores information on the handset while Kamada teaches obtaining a profile for the purposes of selling software or facilitating the exchange of messages. In Kamada, even if it has a reserved data storage area for the wireless communication device for uploading and downloading of files, the software itself is residing on the server and is not utilized until it is downloaded from the reserved storage area. As such, the software does not work as presently claimed because software in the reserved storage area, as in Kamada, must be downloaded, installed,

and executed before it is functional. As such, neither Kamada nor Shanahan could reasonably be expected to succeed in achieving the present claims.

3. Combined References Must Teach All Claim Limitations

With respect to the third prong of an obviousness analysis, the combination of the references does not yield all the limitations of the claims. Specifically, claim 7 requires that the utility programs comprise “a plurality of discrete computer programs managed by an administrative program that allows a single user interface to the plurality of discrete computer programs, the administrative computer program allowing operation of a first of the discrete computer programs which enables access to a portion of the data storage area reserved for the wireless communication device for uploading files and allowing operation of a second of the discrete computer programs which enables access to a portion of the data storage area reserved for the wireless communication device for downloading of files.” Support for this amendment can be found at least in paragraphs 25 and 26.

The Office Action cites Kamada and Shanahan as teaching a utility toolkit, but nowhere in Kamada or Shanahan is a teaching or suggestion that the programs are partitioned as presently claimed. Accordingly Kamada and Shanahan in combination with Shanahan fail to teach this aspect of the claims.

4. Effect of KSR

After the recent Supreme Court decision in the KSR case, although it is clear that the above analysis using the Federal Circuit’s teaching-suggestion-motivation test is not the only way to approach the obviousness inquiry, it remains a useful tool in the obviousness inquiry. However, even if an alternative tool is employed as part of the obviousness inquiry, it is clear from KSR that any combination of references in an

obviousness rejection must provide reasonable inferences that are based on substantial evidence in the record. Here, no such substantial evidence has been identified and therefore even after KSR, Applicant asserts that the pending claims are not obvious in view of the cited references of record.

Summary

In summary, the Office Action cites no passages in the references themselves that suggest or provide any motivation to combine the teachings of Shanahan with Kamada. Further, the Examiner has not demonstrated that the modification of the cited references point to the reasonable expectation of success in the present claims, which is the second requirement of the obviousness analysis. Finally, the combination of Shanahan and Kamada fail to teach independent claim 7. Thus, the combination of Shanahan with Kamada fails to make the claims obvious and Applicant respectfully requests that the rejection of independent claim 7 and its respective dependent claims be withdrawn.

C. Rejection of Claim 22 Under 35 USC §103

In the Office Action, claim 22 has been rejected under 35 U.S.C. 103(a) as unpatentable over Shanahan in view of Kamada and Rooke, and further in view of U.S. Publication No. 2002/0053708 ("Sugiyama"). This rejection is traversed as follows.

Claim 22 depends from claim 1. Applicant has argued that claim 1 is in a condition for allowance in sub-section A. Since claim 22 depends from a claim that Applicant has asserted is an allowable base claim, claim 22 is in a condition for allowance as well.

D. Rejection of Claims 23 – 28 Under 35 USC §103

In the Office Action, claims 23 – 28 were rejected under 35 U.S.C. 103(a) as unpatentable over Shanahan in view of Kamada, and further in view of U.S. Publication No. 2002/0123342 (“Lehaff”). The Office Action relies primarily on Shanahan and Kamada as teaching the elements of the claims, except that the “first network is a wireless communication network and the second network is different from the first network and is a public network.” The Examiner relies on Lehaff for this teaching. The Examiner states that the combination of Shanahan with Kamada and Lehaff would have been obvious to a person of ordinary skill in the art. This rejection is traversed as follows.

Claim 23

Claim 23 includes a limitation that is substantially similar to the limitation added by way of amendment in claim 7. For at least the same reasons outlined with respect to claim 7, claim 23 is not obvious in view of the cited references.

Claims 24-28

Claim 24 includes a limitation that is substantially similar to the limitation added by way of amendment in claim 1. For at least the same reasons outlined with respect to claim 1, claim 24 is not obvious in view of the cited references. Claims 25-28 depend from claim 24. Thus, the combination of Shanahan with Kamada and Lehaff fails to make the claims obvious and Applicant respectfully requests that the rejection of independent claim 23 and independent claim 24 and its respective dependent claims be withdrawn.

E. Conclusion

For all the foregoing reasons, an early allowance of claims 1-13 and 21-28 pending in the present application is respectfully requested. If necessary, applicant requests, under the provisions of 37 CFR 1.136(a) to extend the period for filing a reply in the above-identified application and to charge the fees for a large entity under 37 CFR 1.17(a). The Director is authorized to charge any additional fee(s) or any underpayment of fee(s) or credit any overpayment(s) to Deposit Account No. 50-3001 of Kyocera Wireless Corp.

Respectfully Submitted,

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